

REMARKS

The Examiner has required a restriction between the 18 groups of claims set forth on paragraphs 2-5 of the Office Action. This requirement is respectfully traversed. Reconsideration and withdrawal thereof are requested.

First of all, the Examiner has asserted that the inventions of groups I – XVIII do not relate to a single general inventive concept under PCT Rule 13.1, but Applicants submit that the Examiner has not properly construed or applied the unity of invention standard applicable under PCT Rule 13.

The Examiner will note that no unity of invention objection was raised during the international phase of this application, which also applies the unity of invention standard under PCT Rule 13. An international application which complies with those unity of invention requirements must then be accepted by all of the designated and elected offices, including the USPTO, since Article 27 (1) of the Patent Cooperation Treaty does not permit any national law or national office to require compliance with different regulations relating to the contents of the international application. Thus, the US application must be examined for unity of invention consistent with the Patent Cooperation Treaty. This means that the US Examiner must faithfully apply PCT Rule 13.1 when analyzing unity of invention, not by merely giving verbal assent to the standard but in actual application of the standard. See *Caterpillar Tractor Co. V. Commissioner of Patents and Trademarks*, 231 USPQ 590 (E.D.VA. 1986).

Applicants submit that, consistent with *Caterpillar Tractor Co.*, the Examiner in the present case should follow PCT Rule 13.1, and the unity of invention rejection should be withdrawn.

Applicants also object to the Examiners apparent intention to restrict this application to a single elected species. In the Office Action, the sub-paragraphs which describe groups I – IV each end the emphasized instruction from the Examiner that “this election should not be construed as an Election of Species. This is a Restriction of Requirement.” It appears from these

statements that the Examiner intends to improperly attempt to restrict the present application to Applicant's elected species, and not examine Applicant's generic claims. Any such attempt from the Examiner would be completely contrary to proper USPTO procedures and without authority under the patent statute.

The Examiner's alleged basis for this kind of Restriction Requirement is 35 U.S.C. § 121. But that statutory provision provides the Director with the authority to promulgate rules designed to restrict an **application** to one of several claimed inventions when those inventions are found to be "independent and distinct." It does not, however, provide a basis for an Examiner acting under the authority of the Director to reject any particular claim on the same basis, nor to refuse to examine Applicant's generic claims. An Examiner can properly make a restriction between different **groups of claims** but cannot properly restrict an application by dividing up the subject matter of a **single claim** and making a restriction from within that claim. An Examiner may not, in this manner, refuse to make an examination on the merits of a broad generic claim. Such refusal is tantamount to an attempt to reject the claim under 35 U.S.C. § 121, a rejection which has been viewed with disapproval by the court. This is true even if the broad generic claim covers a plurality of independent patentable species. As stated by Judge Rich,

"It is elementary patent law that the number of 'species' 'covered' by a patent having a generic claim is virtually without limit notwithstanding the limitation of Rule 141 to 5 species "specifically claimed." So the discretionary power to limit one application to one invention is no excuse at all for refusal to examine a broad generic claim- no matter how broad, which means no matter how independently patentable inventions fall within it." In re *Weber*, 198 USPQ 328, 331 – 332 (CCPA 1978)."

Thus, the Examiner is without authority to restrict Applicant to a single elected species from within generic claim 1. The proper procedure for the Examiner to follow is set forth in MPEP § 803.02. Pursuant to that procedure, the Examiner can initially require an election of species, but after that species is found allowable, an examination on the merits must be broadened to encompass other species.

Therefore, in response to the Office Action, Applicant provisionally elects to prosecute the claims of group I (claims 1-8) and provisionally elect the species represented by EpCAM as antigen (a) and Lewis Y as antigen (b). Claim 23 directed to the elected species has been added to the application. However, once claim 23 directed to the elected species has been found allowable, then examination on the merits must be expanded to other species encompassed by Applicant's generic claim.

Favorable action, on all the claims, is therefore, requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

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Respectfully submitted,

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